

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

555255-012690

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on Feb. 3, 2009

Signature Debra Pejeau

Typed or printed name DEBRA PEJEAU

Application Number

10/768,509

Filed

01/30/2004

First Named Inventor

Mihal Lazaridis

Art Unit

2626

Examiner

James S. Wozniak

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 47,919

X

Signature

Joseph M. Sauer

Typed or printed name

216-586-7506

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

X z/2/9

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Lazaridis et al
Title : System and Method for Implementing a Natural . . .
Application No. : 10/768,509
Confirmation No. : 6885
Filing Date : 1/30/04
Examiner : James S. Wozniak
Group Art Unit : 2626
Attorney Docket : 555255012690

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS FOR PRE-APPEAL BRIEF REVIEW

Prior to filing an Appeal Brief, Applicants request review of the final rejection mailed 12/4/08, due to the final rejection having clear errors, and thus failing to make a *prima facie* case of unpatentability.

Any fee due for this submission should be charged to the Jones Day Deposit Account No. 501432, reference 555255012690.

REMARKS

INDEPENDENT CLAIM 2

Independent claim 2 generally relates to how an electronic device processes a user command for launching a software application. The device receives the command as it is being entered by the user and displays to the user a list of probable commands that match what the user entered so far.

Claim 2 is rejected over Beauregard in view of Eide and Laursen. This rejection should be withdrawn, because claim 2 includes the following two limitations (designated A and B) that are not disclosed by the references even in combination:

- A) **while** receiving the command from the user, displaying a list of probable commands; and
- B) after the list is displayed, the user enters remaining characters of the command to narrow the list.

A. The References fail to teach limitation A: displaying a list **while** command text is entered

Limitation A requires the device to display the list of probable commands "while" receiving the command being entered by the user. The Examiner has addressed limitation A in contradictory ways: The **previous** Office Action (mailed 5/23/08) indicated limitation A is taught by Beauregard, col. 42, lines 27-50.¹ In contrast, the **current** Office Action at p. 3 indicates this limitation is instead taught by Eide.² But then, at p. 9, the current Office Action repeats the previous Office Action's assertion that this limitation is taught by Beauregard, col. 42, lines 27-50.

To cover all bases, Applicants note that neither Beauregard nor Eide teach limitation A, of displaying a list of probable commands "while" the command is being entered by the user. Specifically, Beauregard states repeatedly³ that his list is displayed only after the user presses the space bar twice to denote end of command entry. Eide⁴ similarly states that his list is displayed only after the user presses the Tab key to denote end of command entry.

Therefore, the references fail to teach limitation A.

¹ by Examiner stating: "With respect to Claim 2, **Beauregard** discloses: ... **While** receiving the abbreviated textual command performing the steps of: Searching ...; **Displaying a list** of probable complete commands ...**Col. 42, lines 27-50.**)" (previous Office Action, 5/23/08, p.8, emphasis added)

² by Examiner stating: "With respect to Claim 2, the applicant argues that Beauregard ... does not teach displaying a list of probable commands while command text is entered... In response, the examiner notes that in this rejection a section of Beauregard was not cited against this limitation and that on page 9 of the same action, the **Eide** reference (...) was relied upon for such a teaching." (current Office Action, 12/4/08, p.3)

³ col. 9, line 9; col. 15, line 49; col. 17, line 55; col. 38, line 25; col. 42, line 66; col. 44, line 53

⁴ Eide, p. 37: "[T]he user can type just: '1s sou'. At this point, before hitting the Return key, the user can have the shell complete the partially entered directory name. The user can press the **Tab** key." Eide continues explaining, in a footnote, that "If the prefix 'sou' had not been sufficient to uniquely identify exactly one file name, the shell ... would have completed as much of the user's input possible or **displayed a list** of possible completions."

B. The References fail to teach limitation B: entering remaining characters of a command

Limitation B specifies: After the list of probable commands is displayed, the user enters remaining characters of the command to narrow the list. The Office Action (p.10, 3rd par.) asserts this is taught by Laursen. However, Laursen does not narrow a list of probable **commands**. Laursen instead narrows a list of **records** (col. 1, line 15) exemplified as names in an address list.

Laursen's teaching of successively narrowing a list of **names** in response to entered text would not motivate the skilled person to modify Beauregard to successively narrow a list of **commands** to arrive at claim 2. That is because the user would consider doing so to be uncalled-for in Beauregard's application and unlikely to succeed, for the following four reasons: 1) In Laursen, the text being entered is a person's name, whereas in Beauregard, the text is a computer command. 2) In Laursen, the text is entered in response to a query (col. 5, line 67), whereas in Beauregard, the text is entered freestyle on the user's own volition (*e.g.*, entering "dial" command while typing an email in col. 44, line 42). 3) In Laursen, the type of text being entered is pre-defined (*e.g.*, name), whereas in Beauregard, the text is a command to perform any function the computer supports. 4) In Laursen, the user is entering an **unabbreviated** version of the text before the computer displays text suggestions. Whereas in Beauregard, the user's text command can be abbreviated (such as "msw" for Microsoft Word) or unabbreviated. For these four reasons, Laursen's teaching (of successively narrowing a list of **names**) would not suggest successively narrowing Beauregard's list of **commands** to arrive at claim 2.

In conclusion, the references fail to teach two limitations of claim 2 (A and B above). Therefore, the rejection of claim 2 is improper and should be withdrawn.

INDEPENDENT CLAIMS 37

Claim 37 recites the limitations of:

- A) before receiving the entire command, displaying a probable subset of commands; and
- B) the user enters a further portion of the command to narrow the subset of commands.

These limitations are respectively similar to limitations A and B discussed above for claim 2. The Office Action (p. 12-13) asserts these limitations in claim 37 are obvious using the same rationale as for claim 2. The error in the Examiner's rationale for claim 37 is the same as explained above for claim 2. Therefore, the rejection of claim 37 should be withdrawn.

INDEPENDENT CLAIM 48

Claim 48 recites the steps of receiving a text string being entered by a user, comparing a received portion of the text string to stored commands to determine a probable command, and initiating a software operation corresponding to the probable command.

Claim 48 includes the limitation of “the comparing and initiating steps being performed **without the user having entered a delimiter** denoting an end of the text string.” The Office Action (p.7) asserts this limitation is not supported by the specification. Applicants respond this limitation is indeed supported in the application by the following passages in conjunction with Fig. 6 (below):

"[T]he natural language search engine 32 will display a list of possible commands to the user in step 86. In step 88, the user may select from the list of possible commands, or alternatively may narrow the list by entering more text." (application, p.8, lines 2-4)

and

"For example, the user may chose ... "e_j" to always represent the user command 'email jim.' In this manner, **only two key strokes** are required to invoke the email composer application 34, and select the addressee 'jim!'" (application, p.9, lines 1-5, emphasis added)

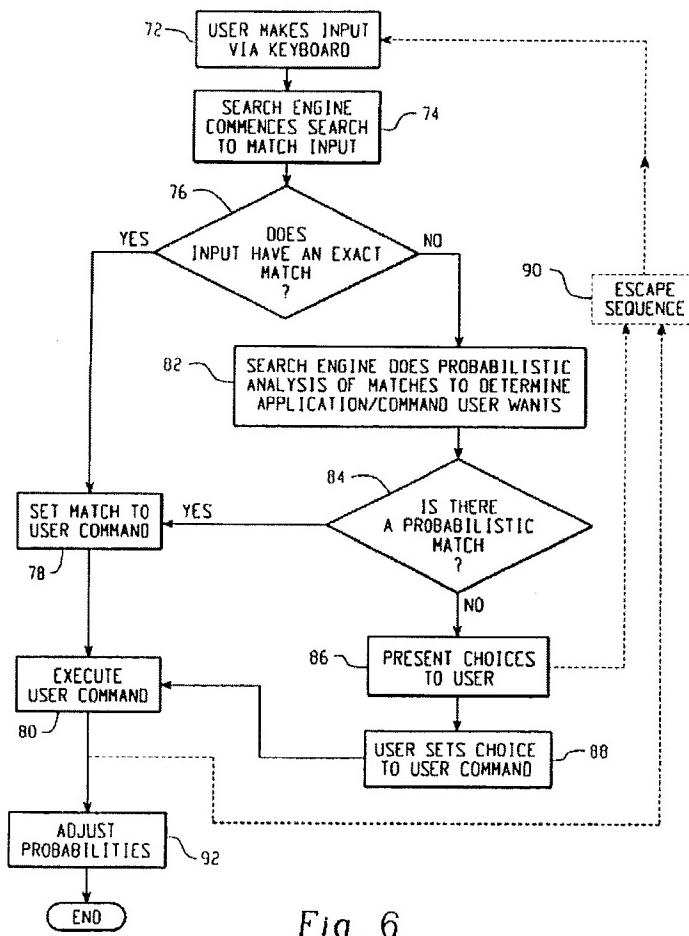


Fig. 6

The Office Action (p.14) further asserts this limitation is made obvious by Laursen's process of entering text without a delimiter to narrow a list of **names**. Applicants respond that the skilled person would not have applied Laursen's teaching of listing **names** to Beauregard's system of executing **commands** to arrive at claim 48 for the reasons listed above (numbered 1-4) regarding claim 2.

Since this limitation (of comparing and initiating steps performed **without the user having entered a delimiter** denoting end of text string) is indeed supported by the application and not taught by the cited art, the rejection of claim 48 should be withdrawn.

INDEPENDENT CLAIM 56

Claim 56 recites displaying a list of frequently used commands "**as soon as** the user begins entering the command text string."

This limitation is not disclosed by the cited references to Beauregard and Snapper. The Office Action (p.18) notes that Beauregard presents a list of probable commands. However, Beauregard does not do this "**as soon as** the user begins entering the command text string" as claimed, but instead only after the space bar is pressed twice to indicate the **end** of command entry. And Snapper's listing of **names** is irrelevant to Beauregard's listing of **commands** for reasons numbered 1-5 in the Amendment filed 10/24/07 at p.8. Therefore, the rejection of claim 56 should be withdrawn.

DEPENDENT CLAIMS 5-13, 41-45 AND 49-50

The remaining claims all depend from base claims that are explained above to be patentable over the prior art. The limitations that the dependent claims add to the base claims distinguish them further from the prior art.

Respectfully submitted,

Mitchell Rose

Mitchell Rose (Reg. No. 47,906)
JONES DAY
901 Lakeside Ave.
Cleveland, OH 44114
(216)586-7094

2/3/09